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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Miskin & Tsui-Yip LLP 1350 Broadway, Suite 802 NEW YORK, NY 10018			EXAMINER DARNO, PATRICK A	
			ART UNIT 2158	PAPER NUMBER
			MAIL DATE 07/08/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/561,118

Applicant(s)

BOYLE, SEAN

Examiner

PATRICK A. DARNO

Art Unit

2158

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 6-8, 10, 14, 15 and 21-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 11-13, 16-20 and 27-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 27-36 are new. No claims are canceled. Claims 6-8, 10, 14, 15, 21, and 21-26 are withdrawn from consideration. Claims 1-5, 9, 11-13, and 16-20 are amended. Claims 1-36 are pending in this office action.
2. Claims 6-8, 10, 14, 15, 21, and 21-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. The Applicant is reminded that should any of claims 1-5, 9, 11-13, 16-20, and 27-36 become allowable, the claims now listed as withdrawn, will need to be canceled.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 9, 11-13, 16, 17, and 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication Number 2002/0126005 issued to Gordon E. Hardman et al. (hereinafter “Hardman”).

Claim 1:

Harman discloses a system for tracking an object comprising:

at least one device for encoding a medium coupled to the object with a unique identifier identifying the object and for reading the identifier [Hardman: paragraph [0084], lines 1-5 and paragraph [0096]];

an object management database for storing, in association with the object via the identifier [Hardman: paragraph [0077], lines 1-2 and paragraph [0057], lines 1-3], performance information, comprising at least one object—elated performance characteristic [Hardman: paragraph [0084]], and servicing information, identifying at least one service operation on the object provided by a service provider [Hardman: paragraph [0084] and paragraph [0103]], for object tracking, at least a portion of said servicing information being provided by said service provider [Hardman: paragraph [0057], lines 1-3 and paragraph [0076]]; and

a processor [Hardman: paragraph [0086], lines 1-4] operatively coupled to the object management database for managing retrieval, storage, and distribution of performance information and servicing information between at least the object management database and the service provider [Hardman: paragraph [0085], lines 1-11 and paragraph [0084] and paragraph [0096]].

Claim 2:

Hardman discloses all the elements of claim 1, as noted above, and Hardman further discloses wherein the object is a tire (Hardman: Paragraph [0055], lines 1-4 and paragraph [0056], lines 1-4 and paragraph [0084]) and the performance characteristic is a tire-related performance characteristics (Hardman: paragraph [0084]).

Claim 3:

Hardman discloses all the elements of claim 1, as noted above, and Hardman further discloses wherein the medium is a radio frequency identification (RFID) tag (Hardman: paragraph [0082], lines 1-5 and paragraph [0088]).

Claim 4:

Hardman discloses all the elements of claim 1, as noted above, and Hardman further discloses wherein the identifier to the object is based at least in part on **at least one of** a year of manufacture, an object manufacturer [Hardman: paragraph [0095] and paragraph [0096] and paragraph [0084]], an object description and a service provider.

Claim 5:

Hardman discloses all the elements of claim 1, as noted above, and Hardman further discloses wherein the system further comprises a registration database operatively coupled to the processor for storing **at least one** of the identifier, an object manufacturer ID, an object description ID and a service provider ID (Hardman: paragraph [0077], lines 1-6 and paragraph [0095] and paragraph [0096] and paragraph [0084]).

Claim 9:

Hardman discloses all the elements of claim 8, as noted above, and Hardman further discloses wherein one of said at least one device is for both said encoding and said reading (Hardman: paragraph [0098] and paragraph [0159] and paragraph [0218]).

Claim 11:

Hardman discloses all the elements of claim 2, as noted above, and Hardman further discloses wherein each object-related performance characteristics is **selected from a group** consisting of: pressure, temperature, mileage, tread depth, tire failures, retreadings, recall date, warranty, and age (Hardman: paragraph [0084]).

Claims 12, 13, 16, 17:

Claims 12, 13, 16, and 17 are rejected under the same or similar reasons to those set forth in the rejections of claims 1-5, 9, and 11.

Claim 27:

Hardman discloses all the elements of claim 5, as noted above, and Hardman further discloses a registration authority for determining, at least in part, the identifier for assigning to the object [*Hardman: paragraph [0084], lines 1-5 and paragraph [0096]*]; Note that the identifier is “provid[ed]”, “programmed”, or assigned.].

Claim 28:

Hardman discloses all the element of claim 27, as noted above, and Hardman further discloses wherein the registration authority manages the registration database [*Hardman: paragraph [0077], lines 1-2 and paragraph [0057], lines 1-3*].

Claim 29:

Hardman discloses all the elements of claim 2, as noted above, and Hardman further discloses wherein the service operation is at least one of a service operation provided by a garage, a repair station and a tire rotation [*Hardman: paragraph [0084] and paragraph [0103]*].

Claim 30:

Hardman discloses all the elements of claim 1, as noted above, and Hardman further discloses wherein said at least one device is used for communicating at least one of said performance information and said servicing information with the processor [*Hardman: paragraph [0084] and paragraph [0103]*].

Claim 31:

Hardman discloses all the elements of claim 1, as noted above, and Harman further discloses wherein there are at least two service providers [*Hardman: paragraph [0084] and paragraph [0103]*]; Duplication of known components is not invention. See MPEP 2144.04 VI B.).

4. Claims 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication Number 2003/0006121 issued to Kenneth Yukou Lee et al. (hereinafter "Lee").

Claim 18:

Lee discloses a method of encoding a medium for identifying an object comprising:

- a) at a service provider, generating an identifier based on at least one characteristic associated with the object (*Lee: paragraph [0017] and paragraph [0018], lines 1-5*);
- b) updating a list of object identifiers, stored at a database accessible at the service provider, to prevent a conflict in the list of object identifiers (*Lee: paragraph [0018], lines 9-13*);
- c) writing the identifier to the medium operatively coupled to the object (*Lee: paragraph [0018], lines 1-5*); and
- d) registering the object in a central database, associated with the service provider (*Lee: paragraph [0018], lines 9-13*).

Claim 19:

Lee discloses all the elements of claim 18, as noted above, and Lee further discloses wherein the medium is a radio frequency identifier (RFID) tag, whereby the identifier is written as a unique 96-bit number (*Lee: paragraph [0017] and paragraph [0018], lines 1-5*).

Claim 20:

Lee discloses all the elements of claim 19, as noted above, and Lee further discloses wherein the unique 96-bit number is divided into a plurality of numerical number blocks, and each numerical block representing a selected characteristic associated with the object (*Lee: paragraph [0017] and*

paragraph [0018], lines 1-5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 32-36 rejected under 35 U.S.C. 103(a) as being unpatentable over Lee, and further in view of Hardman.

Claim 32:

Lee discloses all the elements of claim 18, as noted above, but Lee fails to expressly disclose wherein the identifier is based at least in part on at least one of a year of manufacture, an object manufacture, an object description, and a service provider.

However, Hardman discloses wherein the identifier is based at least in part on **at least one** of a year of manufacture, an object manufacturer [*Hardman: paragraph [0095] and paragraph [0096] and paragraph [0084]*], an object description, and a service provider.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Lee with the teachings of Hardman noted above. The skilled artisan would have been motivated to improve the teachings of Lee per the above for the purposes of monitoring large tires in off-road vehicles (*Hardman: paragraph [0003]*). Such tires are expensive and require regular maintenance in order to operate effectively (*Hardman: paragraph [0003]*). Furthermore, the combination is presumed valid because the combination of Lee and

Hardman would yield the predictable result of monitoring a tire's characteristic with RF technology.

Claim 33:

Lee discloses all the elements of claim 18, as noted above, but Lee fails expressly disclose wherein the object is automobile industry related.

However, Hardman discloses wherein the object is automobile industry related [*Hardman: paragraph [0055], lines 1-4 and paragraph [0056], lines 1-4 and paragraph [0084]*], an object description, and a service provider.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Lee with the teachings of Hardman noted above. The skilled artisan would have been motivated to improve the teachings of Lee per the above for the purposes of monitoring large tires in off-road vehicles (*Hardman: paragraph [0003]*). Such tires are expensive and require regular maintenance in order to operate effectively (*Hardman: paragraph [0003]*). Furthermore, the combination is presumed valid because the combination of Lee and Hardman would yield the predictable result of monitoring a tire's characteristic with RF technology.

Claim 34:

Claim 34 is rejected under the same reasons set forth in the rejection of claims 4 and 32.

Claim 35:

Claim 35 is rejected under the same reasons set forth in rejection of claim 20 and 32.

Claim 36:

Claim 36 is rejected under the same reasons set forth in the rejections of claims 20, 32, and further in view of Lee: paragraph [0018] (Note that the currency block appears to be the sum of the currency data used to authenticate the amount of currency (Lee: paragraph [0018] and specifically paragraph [0018], lines 10-13).).

Response to Arguments

Applicant Argues:

While Hardman teaches a tire tag storing information sensed by a tire tag sensor, amended claims 1 and 12 recite that at least a portion of the servicing information is provided to by the service provider. In Hardman the information is not provided by the service provider, but limited to that sensed via tire tag sensors.

Examiner Responds:

Examiner is not persuaded. Hardman discloses wherein the data sensed by the sensor is compared to “program limits, wheel position, tire identification...” [Hardman: paragraph [0084], lines 10-16; The comparison is part of the “determination” step.]. It appears that these “limits” for adequate functionality are set by the service provider [Hardman: paragraph [0084], lines 10-16; see “tire shop” which provides the service of fixing the tire if needed.].

Since it appears that each and every element of the Applicant’s claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Applicant Argues:

In fact, Hardman teaches away from such a system and method as recited in amended claims 1 and 12 by teaching a device that is limited to information that can be sensed by the tire tag. Relying merely on sensed data does not allow for a system storing performance information or servicing information, with at least a portion of said servicing information being provided by a service provider.

Examiner Responds:

Examiner is not persuaded. As shown above, Hardman is clearly mapped to each and every element of the claimed invention as a 35 U.S.C. 102 reference. Since the claims 1 and 12 are rejected under a single reference, and the reference discloses each of the claim limitations, it cannot “teach away” from the claimed invention. Typically, a may reference “teach away” from another reference when it is combined as part of a 35 U.S.C. 103(a) rejection.

The rejections set forth above are maintained.

Applicant Argues:

In contrast, the Lee system is concerned with identifying and tracking currency. As such the Lee identifier contains data such as the currency amounts and serial number. A tracking system for currency is designed to identify, count and authenticate the currency. Accordingly this reference does not teach, hint, or even suggest generating an identifier based on a service provider for servicing an object.

Examiner Responds:

Examiner is not persuaded. The Examiner reminds the Applicant that the Examiner is entitled to give the claim language its broadest reasonable interpretation. There is no language in the independent claims which limits the claimed “object” such that it can not be interpreted as a currency. The RFID associated with the currency in the Lee reference appears to be perform the equivalent of the functional steps claimed by the Applicant. As a result, the claims remain rejected under the reasons set forth in the preceding office action.

The rejections will be maintained in the future under this interpretation until the claims are limited in order to clarify what the “object” is, and more specific limitations to “tracking the object”. Until that time, it appears that the currency tracking of Lee discloses the equivalent steps of object tracking as claimed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICK A. DARNO whose telephone number is (571)272-0788. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ali can be reached on (571) 272-4105. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick A. Darno/
Examiner
Art Unit 2158
07-06-2009

PAD

/Yicun Wu/

Primary Examiner, Art Unit 2158